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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,031	04/12/2005	Stephen Rodney Cumpson	NL 020988	5038

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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

OLSON, JASON C

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/531,031	Applicant(s) CUMPSON, STEPHEN RODNEY	
	Examiner Jason C. Olson	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The allowability of dependent claim 2, as stated in the previous office action, is currently withdrawn.

The objection to the Drawings, as stated in the previous office action, is currently withdrawn. However, a new objection to the Drawings is currently stated.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “method comprising the steps of: (a) monitoring an average retrieval rate with which data is retrieved from the first memory; (b) determining whether the average retrieval rate drops below the nominal data retrieval rate; (c) when the average retrieval rate drops below the nominal data retrieval rate, determining a part of the data of which retrieval causes the drop of the average retrieval rate; (d) adding to the list a reference to the allocation units in which data is stored of which the retrieval causes the drop of the average retrieval rate.” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In determining statutory requirements, the first step is to establish, precisely, what the applicant has invented and is seeking to patent. See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Section II. Claim 7 is seemingly a patentable apparatus, however, it is clear to the examiner that the applicant is seeking to patent the programmed steps, not the memory and processor. Program steps can be patentable subject matter covered by a judicial exception under 35 U.S.C 101 (i.e. an abstract idea), however, there has to be a practical application in the claim of such a judicial exception. See *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Section IV (C) (2). Claim 7 is directed to a judicial exception to 35 U.S.C. 101

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and is not directed to a practical application of such judicial exception, because the claim does not require any physical transformation or the invention as claimed does not produce a useful, concrete, and tangible result.

Claim 1 and claim 7 are essentially claiming the same thing because claim 7 is effectively claiming the programmed steps that are recited in claim 1. Therefore, claim 1 is rejected for the same reasons as claim 7; that is claim 1 is directed to a judicial exception to 35 U.S.C. 101 and is not directed to a practical application of such judicial exception, because the claim does not require any physical transformation or the invention as claimed does not produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites, “an apparatus as claimed in 7 and the first memory” in lines 2 and 3 of the claim. However, the limitation of the first memory is redundant because claim 7 successfully recites the limitation of “a first memory”. The examiner is not sure what the applicant regards as the invention because the only limitation in claim 9 is a redundant limitation; therefore the claim is rendered indefinite.

Response to Arguments

Applicant's arguments with respect to claims 1 and 3-9 have been considered but are moot in view of the new ground(s) of rejection. Claims 1 and 3-9 currently stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

However, the examiner would like to respond to one argument made by the applicant. The applicant states on page 6 of the Remarks that "claim 7 is capable of retrieving data from a first memory. However, this apparatus does not include the first memory." The examiner respectfully disagrees with the applicant. Claim 7 not only mentions a first memory, but modifies the structure of the first memory, i.e. "the first memory being divided into allocation units". Furthermore, in section (g) of claim 7, applicant clearly pulls the limitation of a first memory into the scope of the claim by stating that the "a second part of the requested data is retrieved from the first memory," since the examiner would have to give patentable weight to this limitation. The limitation in section (g) is not written in "capable of" language, but is written in a required and exact manner, which "requires" the second part of the requested data be retrieved from the first memory.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Olson whose telephone number is (571)272-7560. The examiner can normally be reached on Monday thru Thursday 7:30-5:30; alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571)272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCO


Andrea Wellington
Supervisory Patent Examiner